

REMARKS

Claims 2-5 and 7-14 are pending in this application. By this Amendment, claims 2 and 7-13 are amended to correct minor informalities therein. No new matter is added.

Reconsideration of the application is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issues requiring further search and/or consideration (since the amendments place the claims in better form by correcting minor informalities contained therein); (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

Applicants appreciate the allowance of claims 2-5 and 7-9. Applicants have amended claims 2, 7 and 8 to correct minor informalities therein. Further, Applicants submit that pending claims 10-14 are also allowable for at least the reasons discussed below.

Claims 10-12 are rejected under 35 U.S.C. §102(e) over *Tyler, Denise, Microsoft Front Page 97*, Sams, net Publishing, January 17, 1997, pgs. 3-29 (hereinafter "Tyler"). The rejection is respectfully traversed for at least the following reasons.

Tyler fails to disclose the combination of features recited in amended claim 10, including, *inter alia*, a method of authoring a document, comprising linking a goals outline comprising organization of document information content to a presentation outline based on the inputs and the data, generating a card based on the external information, and storing the card as data in the memory, wherein the goals outline is linked to the presentation outline via the card.

For at least these reasons Applicants submit that Tyler fails to disclose all the features recited in claim 10. Accordingly, Tyler fails to anticipate all the features of claim 10, as well as all the features of claims 11-12, which depend from claim 10.

Claims 13 and 14 are rejected under 35 U.S.C. §103(a) over Tyler in view of U.S. Patent No. 5,347,628 issued to Brewer et al. (hereinafter "Brewer"). The rejection is respectfully traversed for at least the following reasons.

The combination of Tyler and Brewer fails to disclose or suggest a method of authoring a document, comprising, *inter alia*, linking a goals outline comprising organization of document information content to a presentation outline based on the input and the data, and displaying on a display device a meta-level display of the goals outline and the presentation outline.

Page 6 of the Office Action acknowledges that Tyler does not disclose the displaying step of claim 13, but alleges that Brewer overcomes the deficiencies of Tyler. Further, the Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tyler and Brewer to result in a method with all the features recited in claim 13. More particularly, the Office Action states that the 'stored files' 35 of Brewer show the organization of information content and the calendar 23 of Brewer is the presentation outline.

First, Applicants respectfully submit that the calendar icon 23 of Brewer merely activates a calendar, and is in no way a presentation outline of a document, as recited in claim 13. Further, reference number 35, which is identified in the Office Action, is a window (col. 4, line 10), which merely shows the files which are in the drawer. Nowhere does Brewer suggest or disclose that the files (1) comprise a goals outline comprising organization of document information content or (2) the files themselves in some fashion form a goals outline for a document.

Second, Applicants respectfully submit that the Examiner's reason for combining Tyler and Brewer is without merit because neither reference discloses any reasonable nexus between a graphical image document of a meta-level display and linking a presentation outline to a goals outline to author a document. Further, the Office Action fails to provide a clear and particular suggestion, teaching, or motivation to combine the references which is an "essential evidentiary component of an obviousness holding". Rather, the Office Action merely provides a broad conclusory statement about the results of the combination - the after-effect of the combination of the references, which is not evidence of motivation to combine these references.

That the prior art can be modified in the manner suggested by the Examiner does not render the modification obvious unless the prior art suggests the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-4 (Fed. Cir, 1992). Second, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). As neither applied reference even suggests any reasonable nexus between a graphical image document of a meta-level display and linking a presentation outline to a goals outline to author a document, and as neither reference discloses a meta-level display of a goals outline and/or a presentation outline, the Office Action's motivation for modifying Tyler to achieve the claimed invention must be based on speculation and/or impermissible hindsight.

For at least the reasons discussed above, Applicants respectfully submit that the combination of Tyler and Brewer fails to disclose or suggest all the features of claim 13, as well as all the features of claim 14, which depends from claim 13. It is requested that the rejection be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 10-14 in addition to already allowed claims 2-5 and 7-9 are earnestly solicited.

Applicants do not believe any additional extensions of time are required at this time. However, the Commissioner is hereby authorized to charge any additional fee associated with this communication to Deposit Account No. 15-0461.

Should the Examiner believe that anything further would be desirable to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

Maryam M. Ipakchi

James A. Oliff
Registration No. 27,075

Maryam M. Ipakchi
Registration No. 51,835

JAO:MMI/ccs

Date: May 11, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE
AUTHORIZATION
Please grant any extension
Necessary for entry;
Charge any fee due to our
Deposit Account No. 24-0037